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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,328	01/20/2006	Alois Maier	HUBR-1291	2248
24972 7590 09/21/2009 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198				
EXAMINER				
NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,328

Applicant(s)

MAIER ET AL.

Examiner

Patrick D. Niland

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-36, 38-45 and 47-60 is/are pending in the application.
- 4a) Of the above claim(s) 57-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-36, 38-45 and 47-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/9/09 has been entered.

The amendment of 7/9/09 has been entered. Claims 26-36, 38-45, and 47-60 are pending.

2. Newly submitted claims 57-60 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

A. Restriction to one of the following inventions would have been required under 35 U.S.C. 121:

- I. Claims 26-36, 38-45, and 47-56, originally presented and examined, drawn to a polyurethane dispersion and method of making, classified in class 524, subclass 591 among others.
- II. Newly presented claims 57 and 60, drawn to a method of sealing a building material, classified in class 427, subclass 372.2 among others.
- III. Newly presented claim 60, drawn to a method of adhering building materials, classified in class 156, subclass 331.1 among others.

B. The inventions are independent or distinct, each from the other because:

i. Inventions of group I, particularly the composition claims thereof and newly presented groups II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product

as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the composition has a different method of use from each of those of groups II and III as shown by the independent and distinct uses of groups III and II respectively. Furthermore, the composition of group I can be used to make a free standing film or three dimensional molded articles.

ii. Inventions of group I, particularly the methods of making the compositions of group I and groups II and III are directed to related distinct processes. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. The invention of group I makes a composition and does not require the steps of groups II or III, which result in coated substrates or adhered materials, which are different effects, designs, modes of operation, and functions. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

C. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of an invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 57-60 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

See also MPEP 706.07(h), particularly “Applicants cannot file an RCE to obtain continued

examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions). See 37 CFR 1.145. Any newly submitted claims that are directed to an invention that is independent and distinct from the invention previously claimed will be withdrawn from consideration and not entered.”

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 38 and 47-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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A. The instant claims 38 and 47-49 recite “comprises” or “comprising” while the claim that they depend from recites “consisting”. It is unclear what is intended by this broadening language and it is unclear how this further limits the instant claim 26, as is required by rule. It is noted that “comprising” in the method claims allows different steps including reactions with different reactants, which broadens the composition claim 26 rather than further limiting it, as required by rule. This further raises the issue as to how the method limitations of claims 47-49 further limit the compositions of claim 26.

5. Claims 38 and 47-49 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

A. The instant claims 38 and 47-49 recite “comprises” or “comprising” while the claim that they depend from recites “consisting”. This broadening language does not further limit the instant claim 26, as is required by rule. It is noted that “comprising” in the method claims allows different steps including reactions with different reactants, which broadens the composition claim 26 rather than further limiting it, as required by rule.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 26-36, 38-45, and 47-56 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6462127 Ingrisch et al..

Ingrisch discloses the instantly claimed polyurethane dispersions at the abstract; column 1, lines 4-67; column 2, lines 1-67; column 3, lines 1-67, particularly 44-67 which broadly encompasses the instantly claimed invention; column 4, lines 1-67, particularly 18-67, which encompasses the instantly claimed ingredients and amounts thereof. It is noted that the instant claim recites ">12" regarding component A and the disclosure's preferred amount of the instantly claimed component A is 0.3-12%. However, the amount of the patentee is based on the amount of their component H. Before addition of the patentee's component H, the patentee's component A is present in a greater amount than when H is added, e.g. consider the patentee's 12% of A which gives $12/(88 \text{ of all components but A} + 12 \text{ of A})$ and removal of the lower amount of H of the patentee, i.e. 5% which gives $12/((88-5) + 12)$ which is about 12.6% of A. Removing larger amounts of the patentee's H and using 12% of the instantly claimed A in the patentee's compositions clearly gives even larger amounts of A in the patentee's compositions, which meets the instant claims using more than 12% of the instantly claimed component A.

Furthermore, the patentee's preferred amount of 0.3-12% overlaps with the instantly claimed ">12" regarding component A because the mathematical precision of each claimed number is such that they read only on the values that round off to "12". Thus, the instant claims are taken to include e.g. 11.9 while the patentee's disclosure is taken to include e.g. 12.1, within mathematical principles. Furthermore, one cannot measure the claimed amounts to within a

single molecule of the claimed material. Thus, the claimed values overlap within experimental error for this reason. The preferred nature of the patentee's upper limit of 12 is taken as disclosing the portion of the patentee that overlaps with the instant claims for the reasons stated above so as to constitute being disclosed with sufficient specificity so as to anticipate the instantly claimed amount of component A.

Thus, the intermediate of the patentee prior to addition of their component H has the instantly claimed amount of A. The ingredients of column 5, lines 1-8 are additional to those of the instant claims. Taking the amounts of column 5, lines 1-8 of the patentee from the patentee's composition and using the larger amounts of the instantly claimed component A of the patentee gives amounts within those of the instant claims since removing the amounts of column 5, lines 1-8 lowers the amount of the denominator used to calculate the amounts. Furthermore, the amounts overlap due to experimental error in making such measurements and because the broader disclosure of the patentee encompasses larger than the preferred amounts of the instantly claimed component A. Note also column 5, lines 9-67; column 6, lines 1-67, column 7, lines 1-67; column 8, lines 1-67; column 9, lines 1-67; column 10, lines 1-19, which encompasses the instantly claimed high molecular weight; column 11, lines 18-67; column 12, lines 1-67, particularly the method steps and temperatures which fall within the scope of those of the instant method claims; column 13, lines 1-44 which discloses the instantly claimed substrates; and the remainder of the document which encompasses the limitations of the remaining claims, particularly the examples and the claims.

The instant claims 38 and 47-49 recite "comprising" and therefore include the addition of other ingredients due to the open nature of the claims. The instant claims which continue to

recite open language continue to encompass the additional components of the patentee. Column 11, lines 31-48, particularly 44-48 show that the polyurethane dispersion not containing H and I of the patentee is prepared and exists for a finite period of time without the presence of H and I of the patentee. This existence, albeit for a limited time, meets the requirements of the instant claims 26 and 52 in that the intermediate does not contain anything excluded by the recitations of "consisting" of the instant claims. Nothing in the caselaw is seen that would prevent the applicant from adding H and I of Ingrisich to their compositions at some later time. Ingrisich does not exemplify the instantly claimed inventions.

The applicant's arguments have been fully considered but are not persuasive for the reasons stated above. The rejection is maintained for the above reasons.

9. Claims 26-36, 38-45, and 47-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6462127 Ingrisich et al..

Ingrisich discloses the instantly claimed polyurethane dispersions at the abstract; column 1, lines 4-67; column 2, lines 1-67; column 3, lines 1-67, particularly 44-67 which broadly encompasses the instantly claimed invention; column 4, lines 1-67, particularly 18-67, which encompasses the instantly claimed ingredients and amounts thereof. It is noted that the instant claim recites ">12" regarding component A and the disclosure's preferred amount of the instantly claimed component A is 0.3-12%. However, the amount of the patentee is based on the amount of their component H. Before addition of the patentee's component H, the patentee's component A is present in a greater amount than when H is added, e.g. consider the patentee's 12% of A which gives $12/(88 \text{ of all components but A} + 12 \text{ of A})$ and removal of the lower amount of H of the patentee, i.e. 5% which gives $12/((88-5) + 12)$ which is about 12.6% of A.

Removing larger amounts of the patentee's H and using 12% of the instantly claimed A in the patentee's compositions clearly gives even larger amounts of A in the patentee's compositions, which meets the instant claims using more than 12% of the instantly claimed component A.

Furthermore, the patentee's preferred amount of 0.3-12% overlaps with the instantly claimed ">12" regarding component A because the mathematical precision of each claimed number is such that they read only on the values that round off to "12". Thus, the instant claims are taken to include e.g. 11.9 while the patentee's disclosure is taken to include e.g. 12.1, within mathematical principles. Furthermore, one cannot measure the claimed amounts to within a single molecule of the claimed material. Thus, the claimed values overlap within experimental error for this reason. The preferred nature of the patentee's upper limit of 12 is taken as disclosing the portion of the patentee that overlaps with the instant claims for the reasons stated above so as to constitute being disclosed with sufficient specificity so as to anticipate the instantly claimed amount of component A.

Thus, the intermediate of the patentee prior to addition of their component H has the instantly claimed amount of A. The ingredients of column 5, lines 1-8 are additional to those of the instant claims. Taking the amounts of column 5, lines 1-8 of the patentee from the patentee's composition and using the larger amounts of the instantly claimed component A of the patentee gives amounts within those of the instant claims since removing the amounts of column 5, lines 1-8 lowers the amount of the denominator used to calculate the amounts. Furthermore, the amounts overlap due to experimental error in making such measurements and because the broader disclosure of the patentee encompasses larger than the preferred amounts of the instantly claimed component A. Note also column 5, lines 9-67; column 6, lines 1-67, column 7, lines 1-

67; column 8, lines 1-67; column 9, lines 1-67; column 10, lines 1-19, which encompasses the instantly claimed high molecular weight; column 11, lines 18-67; column 12, lines 1-67, particularly the method steps and temperatures which fall within the scope of those of the instant method claims; column 13, lines 1-44 which discloses the instantly claimed substrates; and the remainder of the document which encompasses the limitations of the remaining claims, particularly the examples and the claims.

The instant claims 38 and 47-49 recite "comprising" and therefore include the addition of other ingredients due to the open nature of the claims. The instant claims which continue to recite open language continue to encompass the additional components of the patentee. Column 11, lines 31-48, particularly 44-48 show that the polyurethane dispersion not containing H and I of the patentee is prepared and exists for a finite period of time without the presence of H and I of the patentee. This existence, albeit for a limited time, meets the requirements of the instant claims 26 and 52 in that the intermediate does not contain anything excluded by the recitations of "consisting" of the instant claims. Nothing in the caselaw is seen that would prevent the applicant from adding H and I of Ingrisich to their compositions at some later time.

Ingrisich does not exemplify the instantly claimed inventions.

Ingrisich does not exemplify the instantly claimed inventions.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the ingredients and amounts thereof and the reaction parameters of the instant claims in making the dispersions of the patentee because these are encompassed by the disclosure of the patentee and would have been expected to give the properties of the dispersions of the patentee. It would have at least been obvious to one of

ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed amounts of the instantly claimed component A in the dispersions of the patentee because using one % more than the upper level of the preferred amounts of the patentee that read on the amounts of the instant claims will not give a significantly different result and will give only predictable results to the ordinary skilled artisan, i.e. 12% to 13% is not expected to give much difference and is encompassed by the broad disclosure of the patentee as preferred mode does not teach away from other values and the broad disclosure encompasses broader values of the amount of A. The applicant's arguments have been fully considered but are not persuasive for the reasons stated above and the teachings of the patentee.

The applicant's arguments have been fully considered but are not persuasive for the reasons stated above. The rejection is maintained for the above reasons.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Friday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796